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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,468	04/06/2005	Daisuke Fujiwara	58084US004	4897
32692	7590	11/16/2006	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			CHAN, SING P	
			ART UNIT	PAPER NUMBER

1734

DATE MAILED: 11/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/530,468

Applicant(s)

FUJIWARA, DAISUKE

Examiner

Sing P. Chan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 and 22-29 is/are pending in the application.
- 4a) Of the above claim(s) 28 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 22-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3 and 5-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shionzaki et al. (JP 2001-171570 A) in view of Fujiwara (JP 2000-159426).

As to claims 1 and 6, Shionzaki discloses a tape application jig (1) for applying adhesive tape to an adherend having bent and/or curved portions. Regarding claim 1, the jig in Shionzaki seen clearly in Figures 1-4, 12 and 13 includes the following:

(a) a tape application head (9) for applying the tape (T) under pressure to a surface of the adherend (F);

(b) a guide (4) disposed on the surface of the adherend opposite the tape application head (9) for guiding the jig along the surface of the adherend;

(c) a biasing member (7) for biasing the jig guide and tape application head toward one another to control tape application; and

(d) a tape holding member (13) forming a tape guiding space, which can allow tape to be inserted in any direction including transverse to a direction of movement of tape and in Figures 12 and 13, the member is spaced from the flange (23), i.e. open space, while the apparatus is applying the tape.

Shionzaki et al is silent as to tape holding member structure includes a first and second fixed tape holding members spaced apart so as to define said entrance into the tape guiding space. However, providing a first and second fixed tape holding members spaced apart to define an entrance into the tape guiding space is well known and conventional as shown for example by Fujiwara '426. Fujiwara '426 discloses an apparatus for applying adhesive tape. The apparatus includes a tape attachment component (5) with a notch with an angle of between 5-60°, i.e. an angle cross section and a support frame (12) with a rectangular cross section to form an entrance to the tape guiding space (6). (See English Machine Translation of JP 2000-159426, Paragraphs 28-30 and Figures 7-9) The entrance allow for tape to be inserted in a direction transverse to a direction of movement of the tape through the tape guiding space. (See Figures 10 and 11)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a first and second fixed tape guiding members as disclosed by Fujiwara '426 in the apparatus of Shionzaki et al to provide an tape applicator with a more stabilized tape application and prevent the desorption of the tape from a transit way. (See English Machine translation of JP 2000-159426, Paragraph 10)

As to claims 2 and 3, Shionzaki discloses the jig guide (2) is a block further comprises a guide pin (10) capable of being received in a groove provided in the adherend opposite to the tape applying surface of the adherend.

As to claims 5 and 16, Shionzaki discloses the jig in Shionzaki is capable of being slid continuously on the tape applying surface portion of the adherend irrespective of its shape and without removing and re-attaching the tape application jig.

As to claim 7, Shionzaki discloses the tape application head (9) is a cylindrical member.

As to claim 8, Shionzaki discloses the cylinder is elastic and is thus a surface layer which functions as a slide promoting layer or a buffer layer for the tape.

As to claim 9, Shionzaki discloses the jig guide (2) includes a plate member (12) having a rectangular cross section.

As to claims 10 and 17, Shionzaki discloses the jig guide (2) includes at least one roller (11a).

As to claim 11, Shionzaki discloses the tape holding member (13) further comprises a paper processing member (17) for removing and clearing release paper (TL) of the tape. (See Figures 2, 3, and 12.)

As to claims 12, 14, 18, and 20, the adherend in Shionzaki is part of a window frame of a vehicle.

As to claim 13, Shionzaki uses pressure sensitive adhesive tape.

As to claims 15 and 19, the device used in Shionzaki is capable of handling adhesive-backed paint replacement film. "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being

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claimed does not impart patentability to the claims." *In re Young*, 75 F.2d 996, 25 USPQ 69 (CCPA 1935) (as restated in *re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)).

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shionzaki et al (JP 2001-171570 A) in view of Fujiwara (JP 2000-159426) as applied to claims 1 and 2 above.

The diameter of guide pin (10) in Shionzaki is not detailed, however, it is appreciated that the pin has two diameters, a larger end of the pin contacts the adherend and a smaller end is held in the guide (4). (See Figure 2.) It would have been obvious to one having ordinary skill in the art at the time the invention was made that a diameter of the pin held within the guide of about 1mm to about 5mm is within the purview of the artisan as it is a matter of design choice and can change based on the type of material used to make the guide (4) and the pin (10).

4. Claims 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shionzaki et al. (JP 2001-171570 A) in view of Fujiwara (JP 2000-159426) as applied to claim 21 above, and further in view of Fujiwara (JP 2001-97636).

Shionzaki et al as disclosed above is silent as to a first tape holding member structure has a longitudinal and center axis generally parallel with a longitudinal axis of the tape head, a sloping surface positioned adjacent to a sloping surface of a second tape holding member and extending in the direction transverse to the direction of the movement of the tape and the second tape holding member has a longitudinal and center axis generally transverse to the longitudinal axis of the tape application head and

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first tape holding member and the members are space apart form one another in the direction of movement of the tape through tape guiding space. However, providing a first tape holding member structure has a longitudinal and center axis generally parallel with a longitudinal axis of the tape head, a sloping surface positioned adjacent to a sloping surface of a second tape holding member and extending in the direction transverse to the direction of the movement of the tape and the second tape holding member has a longitudinal and center axis generally transverse to the longitudinal axis of the tape application head and first tape holding member and the members are space apart form one another in the direction of movement of the tape through tape guiding space is well known and conventional as shown for example by Fujiwara '636. Fujiwara '636 discloses an apparatus for applying tape to an adherend. The apparatus includes a first tape holding member structure (6) has a longitudinal and center axis generally parallel with a longitudinal axis of the tape head (3), a sloping surface positioned adjacent to a sloping surface of a second tape holding member (9) and extending in the direction transverse to the direction of the movement of the tape and the second tape holding member (9) has a longitudinal and center axis generally transverse to the longitudinal axis of the tape application head (3) and first tape holding member (6) and the members are space apart form one another in the direction of movement of the tape through tape guiding space and includes an intermediate surface space from the second member sloping surface and positioned a plane that extends through said first tape holding member (6). (See Figure 1)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a first tape holding member structure has a longitudinal and center axis generally parallel with a longitudinal axis of the tape head, a sloping surface positioned adjacent to a sloping surface of a second tape holding member and extending in the direction transverse to the direction of the movement of the tape and the second tape holding member has a longitudinal and center axis generally transverse to the longitudinal axis of the tape application head and first tape holding member and the members are space apart form one another in the direction of movement of the tape through tape guiding space as disclosed by Fujiwara '636 in the apparatus of Shionzaki et al as modified by Fujiwara '426 to providing a tape guiding member that allow for easy inserting of the tape as well as conveying of the tape to the tape head. (See English Machine Translation of the JP 2001-97636, Paragraph 27)

### **Finality**

5. The finality of last office action is withdrawn.

### ***Response to Arguments***

6. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection based on Fujiwara (JP 2000-159426).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sing P. Chan whose telephone number is 571-272-1225. The examiner can normally be reached on Monday-Thursday 7:30AM-11:00AM and 12:00PM-4:00PM.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*Chan Sing Po*

SPC

*CA Fiorilla*

CHRIS FIORILLA  
SUPERVISORY PATENT EXAMINER

*Au 1734*